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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,828

07/12/2005

Ganga Raju Gokaraju

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EXAMINER

VALENROD, YEVGENY

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

09/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,828	<b>Applicant(s)</b> GOKARAJU ET AL.	
	<b>Examiner</b> YEVEGENY VALENROD	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-11, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-16 and 19-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/29/09 has been entered.

Amendment to the claims filed 6/29/09 is acknowledged.

Declaration by Dr. S. Venkateswarlu and remarks filed 6/29/09 have been fully considered.

Rejection of claims 1-5, 12-16 and 19 under 35 USC 103(a) is withdrawn in view of applicants' remarks and the declaration by Dr. S. Venkateswarlu. Examiner agrees with the applicant in that displacement of Mg by Zinc is highly unlikely and in order to facilitate such displacement one would require motivation in selecting specific parameters. Such motivation is lacking.

Rejection of claims 1, 2 and 19 under 35 USC 102(b) is maintained.

Text of the maintained rejection is repeated below followed by reply to applicants' remarks.

### ***New Claim Rejections - 35 USC § 112***

Claims 1-5, 12-16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims comprise the term "double metal salt". It is unclear if the said term requires two metals being present, two hydroxycitric acids moieties being present and/or two different metals being present in the claimed salt. Examiner was unable to find a clear definition of the said term in the applicants specification. For the purposes of this office action the term will be given the broadest interpretation which includes any of the above listed possible meanings.

***Maintained Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shrivastava et al. (US 6,221,901). Shrivastava et al describe preparing Magnesium (-)hydroxycitrate. Although Shrivastava et al do not explicitly describe the compound of general formula (I), said compound is inherently present in the solution. The inherency argument is supported by the fact that all the ingredients required to make the claimed double salt are present in the solution. Since magnesium is capable of making a salt with two anionic components, and hydroxycitric acid has 3 carboxylate groups, it stands to reason that one of the magnesium ions that forms a salt with the 3<sup>rd</sup> carboxylate

groups will have to find another molecule of hydroxycitric acid in order to acquire the appropriate valency.

Claim 19 recites a limitation directed to the intended use of the double metal salt of claim 1. It is well settled that the intended use of a composition or product (e.g. as a cosmetic composition) will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount as instantly claimed. See, e.g., *Ex parte Masham*, 2 USPQ2d, 1647.

### ***Reply to applicants' remarks***

Examiner agrees with applicants' argument directed to lack of support in Shrivastava concerning formation of double HCA salts with two different metals acting as counterions to the carboxylate groups. However due to the indefinite nature of the term "double metal salt" Examiner interprets the said term as meaning two of HCA moieties are part of the same salt complex and the said complex does not require two different metals being present. The above interpretation of the term "double metal salt" is met by Shrivastava et al. when Magnesium HCA salt is described in column 3, line 40. In order to overcome the above rejection Examiner recommends adding the limitation of claim 20 to the independent claim 1 and canceling claim 20 and also amending the "double metal salt" to read double salt.

### ***Conclusion***

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Claims 1-20 are pending.

Claims 1-5, 12-16 and 19-20 are rejected.

Claims 6-11, 17 and 18 are withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yevgeny Valenrod/

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/Paul A. Zucker/  
Primary Examiner, Art Unit 1621